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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
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11 *Ex parte* SUDESH KAMATH, TYSON HOM, and ALLEN LEE
12

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14 Appeal 2008-4623
15 Application 09/833,034
16 Technology Center 3600
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19 Decided: ¹ March 18, 2009
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22 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN and JOSEPH A.
23 FISCHETTI, *Administrative Patent Judges*.
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25 CRAWFORD, *Administrative Patent Judge*.
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28 DECISION ON APPEAL
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31 STATEMENT OF THE CASE

32 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
33 of claims 1, 3-5, 7, 9-24, 26-28, 30, 32-47, 49-51, 53 and 55-69. We have
jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants invented methods and systems for streamlining and simplifying the online ordering process while affording the customer and/or other authorized persons the convenience of modifying or canceling the order after the initial commitment to order the product has been made (Specification 4:9-12).

Independent claim 1 under appeal read as follows:

1. A computer-implemented method of processing an online purchase request from a customer to a vendor over a computer network, comprising the steps of:
receiving, over the computer network, a first online purchase request for a first item;
responsive to receiving the first online purchase request, providing a bifurcated order processing route that requests the customer to choose a first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route causing the first online purchasing request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart to be processed according to the express ordering processing that requires no further input by the customer to execute, and

receiving from the customer a selection of
the first order processing route or the second order
processing route and processing the first online
purchase request according to the customer's
selection.

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Johnson et al.	US 5,712,989	Jan. 27, 1998
Hartman et al.	US 5,960,411	Sep. 28, 1999
Information on Barnes & Noble printed through www.archive.org wherein date of the archived webpage is in the URL of the webpage in YYYYMMDD format (hereinafter "B&N")		

The Examiner rejected claims 1, 3-5, 9-24, 26-28, 32-47, 49-51 and
55-69 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of
Hartman; and rejected claims 7, 30 and 53 under 35 U.S.C. § 103(a) as being
unpatentable over B&N in view of Hartman and Johnson.²

SUMMARY OF THE DECISION

We sustain the rejections of claims 1, 3³, 9-24, 26, 32-47, 49 and 55-
69 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of
Hartman.

We do not sustain the rejections of claims 4, 5, 27, 28, 50 and 51
under 35 U.S.C. § 103(a).

² While claims 7, 30 and 52 are initially listed on page 3 of the Examiner's Answer as only being rejecting in view of B&N and Hartman, page 9 of the Examiner's Answer admits Hartman does not disclose certain aspects of these claims and further cites Johnson as disclosing those aspects.

³ Claim 3 depends on cancelled claim 2 which we assume Appellants intended to make dependent on claim 1. Appellants shall in their next correspondence with the Office, make this correction.

We sustain the rejections of claims 7, 30 and 53 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman and Johnson.

We also use our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection of claims 4, 5, 27, 38, 50 and 51 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman and Official Notice

ISSUES

Did the Appellants show the Examiner erred in asserting that the shopping cart model of B&N could be combined with the single-action ordering of Hartman to render obvious “the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to an express processing procedure that requires no further input by the customer to execute” as recited in independent claims 1, 24 and 37, because Hartman teaches away from being used with the shopping cart model?

Did the Appellants show the Examiner erred in asserting that the shopping cart in B&N corresponds to “a step of enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order process routes” as recited in claims 3, 26 and 49?

Did the Appellants show the Examiner erred in asserting that B&N discloses “the first item includes a uniquely identified and pre-stored list of goods and/or services” as recited in claims 4, 27 and 50?

Did the Appellants show the Examiner erred in asserting that B&N discloses “wherein the list includes an object, the object including at least one of another list and item” as recited in claims 5, 28 and 51?

FINDINGS OF FACT

Specification

Appellants invented methods and systems for streamlining and simplifying the online ordering process while affording the customer and/or other authorized persons the convenience of modifying or canceling the order after the initial commitment to order the product has been made (Specification 4:9-12).

A list, according to the present invention, may include any number of items, each predefined or configurable. Lists, according to the present invention, may be ordered following the express ordering procedure and/or placed in a new shopping cart or added to an existing shopping cart that stores other items and/or lists (Specification 21:19-22:9).

B&N

B&N discloses a system for placing an order by selecting an item and adding the item to a virtual shopping cart (B&N 20-21, 36).

To make a purchase, a user may click an item they would like to order. They will then be taken to the product page. If they are ordering multiple items or gift wrapping is required, the user will add the item to a cart (B&N 37).

The shopper may then choose either Express Checkout or Standard Checkout to order the items in the virtual shopping cart (B&N 37-38).

The Express Checkout procedure includes at least clicking on the Express Checkout button, viewing the secure Confirmation Page, and clicking the Place Order button (B&N 37).

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Hartman

Hartman discloses a method and system for placing an order for an item via only a single action (Figs. 1A-1B; col. 3, ll. 46-69).

Hartman discloses that although the shopping cart model is very flexible and intuitive, it has a downside in that it requires many interactions by the purchaser. If a purchaser is ordering only one item, then the overhead of confirming the various steps of the ordering process and waiting for, viewing, and updating the purchaser-specific order information can be much more than the overhead of selecting the item itself. This overhead makes the purchase of a single item cumbersome. Also, with such an ordering model, each time an order is placed, sensitive information is transmitted over the Internet. Each time the sensitive information is transmitted over the Internet, it is susceptible to being intercepted and decrypted (col. 2, ll. 27-48).

Hartman also discloses a Web page that contains a summary description section 101, a shopping cart section 102, a single-action ordering section 103, and a detailed description section 104. The shopping cart section provides the conventional capability to add the described item to a shopping cart (col. 4, ll. 4-21).

Official Notice

We take Official Notice that bundled software, such as Microsoft Office Suite, may include multiple software applications such as Microsoft Excel and Microsoft Word, and that the accompanying packaging or online description of Microsoft Office Suite includes a listing of the software applications contained therein.

PRINCIPLES OF LAW

Obviousness

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

“[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

Claim Construction

1 While the specification can be examined for proper context of a claim
2 term, limitations from the specification will not be imported into the claims.
3 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.
4 2005).

5 During examination of a patent application, a pending claim is given
6 the broadest reasonable construction consistent with the specification and
7 should be read in light of the specification as it would be interpreted by one
8 of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359,
9 1364 (Fed. Cir. 2004).

10
11 *Citing References*

12 Where a reference is relied on to support a rejection, whether or not in
13 a “minor capacity,” there would appear to be no excuse for not positively
14 including the reference in the statement of rejection. *In re Hoch*, 428 F.2d
15 1341, 1342 n. 3 (CCPA 1970).

16 Our holdings are based on the references cited. In this sense, said
17 holdings do not constitute a new ground of rejection. *In re Cowles*, 156 F.2d
18 551 (CCPA 1946); *In re Christensen et al.*, 166 F.2d 825 (CCPA 1948).

19
20 *Official Notice*

21 Patent Office appellate tribunals, where it is found necessary, may
22 take notice of facts beyond the record which, while not generally notorious,
23 are capable of such instant and unquestionable demonstration as to defy
24 dispute. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970).

ANALYSIS

Hartman discloses several downsides to the shopping cart model (col. 2, ll. 27-48). Appellants argue that this is evidence of a teaching away (Appeal Brief 22-23). As to the specific question of "teaching away," our reviewing court in *In re Gurley*, 27 F.3d at 553 stated:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

A careful reading of Hartman discloses that the alleged downsides of the shopping cart model are really to only certain aspects of one particular shopping cart model. For example, Hartman disapproves of requiring "many interactions by the purchaser" and "the overhead of confirming the various steps of the ordering process and waiting for, viewing, and updating the purchaser-specific order information can be much more than the overhead of selecting the item itself" (col. 2, ll. 27-29, 39-43). In another example, Hartman disapproves of the transmission of sensitive purchaser information over the Internet (col. 2, ll. 44-48). Indeed, Hartman also praises the shopping cart model as being "flexible and intuitive" and even includes shopping cart section 102 on their webpage (Fig. 1A; col. 2, ll. 27-29; col. 4, ll. 9-12). Accordingly, while Hartman discourages methods and systems requiring *certain aspects of one particular* shopping cart model, such as multiple interactions with the purchaser and transmitting sensitive over the Internet, Hartman does not actually teach away from *every aspect* of *all* shopping cart models. See *In re Gurley*, 27 F.3d at 553. Thus, as long as

the combination is not directed to the discouraged aspects of the particular shopping cart model, there is no teaching away.

In combining B&N with Hartman, the Examiner is replacing the multi-step Express Checkout procedure of B&N for the items in a shopping cart (i.e., clicking on the Express Checkout button, viewing the secure Confirmation Page, and clicking the Place Order button) with the single-action ordering of Hartman (Examiner's Answer 4, 11-12). By eliminating several steps and the transmission of sensitive purchaser information over the Internet, this combination does not include any of the aspects discouraged by Hartman. *See In re Gurley*, 27 F.3d at 553. Indeed, the elimination of these discouraging aspects serves as a motivation for combining B&N and Hartman. *See KSR Int'l Co.*, 127 S. Ct. at 1740. Accordingly, the combination of B&N and Hartman in this manner is proper. The Appellants assert that B&N does not disclose "a step enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order processing routes" as recited in claims 3, 26 and 49. Specifically, the Appellants assert that the shopping cart of B&N does not meet the definition of a list set forth on page 21 of the specification, which apparently is limited to a list that counts as only one item in a shopping cart (Appeal Brief 27-28). As an initial matter, while the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims. *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005).

B&N discloses "[c]lick an item you'd like to order. You'll be taken to the product page (If ordering multiple items or gift wrapping is required, add them to your cart.)" (B&N 37) Accordingly, the shopping cart of B&N

includes multiple items and thus meets the broadest reasonable interpretation of a list. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364.

The Examiner asserts that pages 12, 13 and 37 of B&N discloses “the first item includes a uniquely identified and pre-stored list of goods and/or services” as recited in claims 4, 27 and 50, and “the list includes an object, the object including at least one of another list and item” as recited in claims 5, 28 and 51 (Examiner’s Answer 5). However, none of those pages discloses any of the items in the shopping cart being a list. Page 13 of the Examiner’s Answer speculates that one of the items in the shopping cart of B&N could be bundled software such as Microsoft Office Suite. However, Microsoft Office Suite is first introduced in the Examiner’s Answer and thus must be presented as a new ground of rejection. *See In re Hoch*, 428 F.2d at 1342 n. 3. *Compare In re Cowles*, 156 F.2d at 551; *In re Christensen et al.*, 166 F.2d at 825.

NEW GROUND OF REJECTION

We use our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection of claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman and Official Notice.

We take Official Notice that bundled software such as Microsoft Office Suite may include multiple software applications such as Microsoft Excel and Microsoft Word, and that the accompanying packaging or online description of Microsoft Office Suite includes a listing of the software applications contained therein. *See In re Ahlert*, 424 F.2d at 1091. It would have been obvious to sell bundled software, such as Microsoft Office Suite, on online sales systems, such as B&N and Hartman, so as to realize the

1 advantage set forth in Hartman of reducing the number of steps necessary to
2 purchase multiple goods. *See KSR Int'l Co.*, 127 S. Ct. at 1740.

3 Accordingly, under this combination, Microsoft Office Suite is a
4 “uniquely identified and pre-stored list” that meets the recitations of “the
5 first item includes a uniquely identified and pre-stored list of goods and/or
6 services” in claims 4, 27 and 50. Furthermore, Microsoft Excel is the “item”
7 of “at least one of another list and item” recited in “the list includes an
8 object, the object including at least one of another list and item” of claims 5,
9 28 and 51.

10 11 CONCLUSIONS OF LAW

12 The Appellants have not shown that the Examiner erred in rejecting
13 claims 1, 3, 9-24, 26, 32-47, 49, and 55-69 under 35 U.S.C. § 103(a) as
14 being unpatentable over B&N in view of Hartman.

15 The Appellants have shown that the Examiner erred in rejecting
16 claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C. § 103(a) as being
17 unpatentable over B&N in view of Hartman.

18 The Appellants have not shown that the Examiner erred in rejecting
19 claims 7, 30 and 53 under 35 U.S.C. § 103(a) as being unpatentable over
20 B&N in view of Hartman and Johnson.

21 The Appellants have not shown that the Examiner erred in asserting
22 that the shopping cart model of B&N could be combined with the single-
23 action ordering of Hartman to render obvious “the second order processing
24 route affording the customer an opportunity to cause execution of the first
25 and any additional purchase requests placed in the shopping card to be
26 processed according to an express processing procedure that requires no
27 further input by the customer to execute” as recited in independent claims 1,

24 and 37, because Hartman teaches away from being used with the shopping cart model.

The Appellants have not shown that the Examiner erred in asserting that the shopping cart in B&N corresponds to “a step of enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order process routes” as recited in claims 3, 26 and 49.

The Appellants have shown that the Examiner erred in asserting that B&N discloses “the first item includes a uniquely identified and pre-stored list of goods and/or services” as recited in claims 4, 27 and 50.

The Appellants have shown that the Examiner erred in asserting that B&N discloses “wherein the list includes an object, the object including at least one of another list and item” as recited in claims 5, 28 and 51.

We have entered a new rejection pursuant to our authority under 37 C.F.R. § 41.50(b) of claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman and Official Notice.

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Regarding the new ground of rejection, Appellant must, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, exercise one of the following options with respect to the new ground of rejection, in order to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . [; or]

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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